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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PETITION Address to: Office of Petitions Assistant Commissioner of Patents BOX DAC Washington, D.C. 20231	First Named Inventor	Nancy Elisabeth Krauss, et al.
	Application Number	09/844,061
	Filing Date	April 26, 2001
	Group Art Unit	1624
	Examiner	Hong Liu
	Attorney Docket No.	R0070B-REG
	Title	p-(Sulfonyl) Aryl and Heteroarylamines as Anti-Inflammatory Agents

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Sir:

OFFICE OF PETITIONS

PETITION TO RESET REPLY PERIOD (MPEP § 710.06) OR ALTERNATIVELY,
TO REVIVE AN UNAVOIDABLY ABANDONED APPLICATION (MPEP § 711.03(c))

This Petition is submitted pursuant to MPEP § 710.06 to reset the reply period to respond to outstanding Office Actions in this application until one month from the mailing date of the February 26, 2003 Advisory Action, *i.e.*, until March 26, 2003. Alternatively, in the event it is determined that said reply period may not be reset, applicant petitions for the revival of the instant application pursuant to 37 CFR § 1.137(a) and MPEP § 711.03(c). Submitted herewith is (1) a complete reply to the Office Action mailed May 6, 2002, and Advisory Actions mailed February 26, 2003 and September 6, 2002; and (2) a Request for Continued Prosecution of the instant application in the event it is determined that prosecution is closed.

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I. **PETITION FOR RESETTING OF REPLY PERIOD**

MPEP § 710.06 provides that, where “an Office action contains some [] defect and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by the applicant.”

Here, applicant contends that there are defects in the Advisory action of February 26, 2003, explained in further detail below.

Additionally, MPEP § 710.06 states, “where *for any reason* it becomes necessary to remail *any* action ..., the action should be correspondingly redated, as it is the remailing date that establishes the beginning of the period for reply. ... A supplementary action after a rejection explaining the references more explicitly or giving reasons more fully, ... establishes a new date from which the statutory period runs.” (Emphasis supplied).

Applicant submits that the February 26, 2003 action should be considered a *supplementary* action, issued after what should have been a non-final rejection of the claims. Consequently, pursuant to these provisions, applicant petitions that the mailing date of the February 26, 2003 action establish the beginning of the period to now reply.

Applicant submits that idiosyncrasies in the prosecution history support this request. More particularly, the prosecution history in this case shows the following. The original specification was filed on April 26, 2001. A first Office Action was mailed on December 14, 2001, containing *both* a restriction requirement and rejection of claims under Sections 102(b), 103 and 112. In the first Office Action, seven prior art references were cited. On February 26, 2002, applicant timely filed a responsive Amendment. Additionally, a supplemental *non-fee* Information Disclosure Statement (IDS) was filed on February 28, 2002, pursuant to 37 C.F.R. § 1.97(e)(1).

On May 6, 2002, the Examiner issued a second Office Action, with a final rejection of claims 1-19 and 38-43, and setting a three-month shortened statutory response period. In the May 6, 2002 action, the Examiner continued to rely upon two of the seven references cited in the first action of December 14, 2001, namely, the Barton and Okada references. (Notably, applicant subsequently demonstrated that these two references were improperly applied and the continued rejection of the claims based thereon was in error.)

In addition to relying upon Barton and Okada, in the May 6, 2002 action, the Examiner raised a *new grounds* for rejection of the claims under Section 112, *i.e.*, he argued that the recitation of R₂ in claim 1, defining A, was unclear (5/6/02 OA, at p. 3). This rejection was not necessitated by amendments to the claims, because the same reference to R₂ in defining A was present in the claims as originally filed. Furthermore, the May 6, 2002 action raised further new grounds for rejecting claims 1-5 under Sections 102 and 103 based on three references not cited in the first Office Action (*i.e.*, the Billman, Katritzky, and Dinsmore references). These references were supplied to the PTO in the February 28, 2002 IDS. However, as noted above, this was a *non-fee* IDS.

In view of the new Section 112 rejection and the non-fee status of the supplemental IDS, it was premature for the Examiner to characterize the May 6, 2002 action as a final rejection:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) *with the fee set forth in 37 CFR 1.17(p)*. Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) *with a fee*, the examiner may use the information submitted and make the next Office action final whether or not the claims have been amended, *provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the Examiner*. [MPEP 706.07(a)] (emphasis supplied).

Here, a new Section 112 rejection had been raised, and the IDS was a non-fee submission under 37 CFR 1.97(e)(1), not 1.97(c).

Applicant timely responded to the second action of May 6, 2002, with an amendment and remarks filed on August 6, 2002. In this Amendment, applicant argued that the Barton, Okada and Dinsmore references were improperly interpreted and/or applied, and amendments to the claims were made to overcome the newly-raised rejections based on Billman and Katritzky. Applicant also added new claims 50-56 to claim the invention in an alternative way, given the amendment to claim 1. Review of the record shows that new claim 50 in this August 6, 2002 amendment was identical

in scope with claim 1 in applicant's previous, February 26, 2002 amendment (as presented in clean form),¹ except alkyl was omitted as a possible selection for the group R¹ in new claim 50.

On September 6, 2002, the PTO issued an Advisory Action, stating that all of the rejections had been overcome, except for the Section 103 rejection based on Dinsmore and an antecedent basis objection that was noted for claim 38. The Examiner refused to enter new claims 50-56 on the ground that they were not commensurate in scope claim 1 as *then* amended and required a new search. [Despite this finding, claim 50 removed alkyl as a selection for R¹ but otherwise was identical to claim 1 as amended in the earlier, February 26, 2002 response – which was the subject of search and examination. The case law instructs that it is not new matter to excise from the scope of a claim a species or selection in view of cited references. *See In re Johnson*, 194 USPQ 187, 196 (C.C.P.A. 1977).² Since claim 1 of the February 26, 2002 response was searched, it is difficult to see the logic in the Examiner's finding that this new claim, removing an alkyl selection from that claim scope, would require a new search.]

In any case, the record reflects that there was a telephonic interview on September 23, 2002, apparently for the purpose of resolving all outstanding issues. Further to that interview, the applicant submitted an amendment with remarks on October 2, 2002. In this response, applicant amended claim 1 in order to overcome the Examiner's application of Dinsmore. In particular, the applicant incorporated the definition of "substituted heteroaryl" from the specification into claim 1, and with this definition, applicant explicitly recited that "phenyl" or "phenylalkyl" meant

¹ There was a typographical error in the February 26, 2002 amendment in that the clean form limited claim 1 to compounds where X and Y were CH, in response to the restriction requirement, but these changes were not reflected in the marked-up version.

² In *In re Johnson, supra*, the appellant had inserted two provisos into claim 1 of his application to carve out from the generic claim two particular species that were lost in an interference. *See* 194 USPQ at 191. Chief Judge Markey of the Court of Customs and Patent Appeals (predecessor court to the Federal Circuit), held that the provisos did not constitute "new matter":

The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach to those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of § 112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute.[A]ppellants are merely excising the invention of another, to which they are not entitled, and are not creating an "artificial subgenus" or claiming "new matter." [*Id.* at 196].

“unsubstituted phenyl” and “unsubstituted phenylalkyl.” Further, new claims 50-56 were not presented in this latest amendment.

Thus, the record reflects that applicant had acquiesced to each of the Examiner’s arguments, and applicant thus had good reason to believe all outstanding issues had been resolved. However, there was a delay in the PTO’s transmittal of the October 2, 2002 Amendment to the Examiner. The undersigned communicated with Examiner Hong Liu by telephone on March 19, 2003, and Examiner Liu then agreed that there was a delay in the transmittal of this amendment attributable to the USPTO’s handling of the papers (at no fault of the applicant).

In view of that delay, an Advisory Action was not mailed until February 26, 2003. This action stated that it was re-establishing the response period to run five months from the mailing date of the final rejection (*i.e.*, five months from May 6, 2002). However, this time period had already expired in October 2002, and the six month period had expired on November 6, 2002.

In the February 23, 2003 Advisory Action, the Examiner argued that the amendment to the claims presented in the October 2, 2002 response raised new issues requiring a new search. That is, the Examiner argued that, the amendment which explicitly recited that “phenyl” or “phenylalkyl” meant “unsubstituted phenyl” and “unsubstituted phenylalkyl” raised new issues and required a new search. [Again, it is difficult to see the logic in this finding. The definition of “substituted heteroaryl” in the original specification includes a reference to phenyl and phenylalkyl (at page 5, line 28). Dinsmore had been applied to the claims on the assumption that the reference to phenylalkyl could be interpreted to encompass not only unsubstituted phenylalkyl but also a 4-cyanobenzyl moiety. Since the definition had recited just “phenylalkyl,” the Examiner in searching the original claims naturally must have searched for compounds having unsubstituted phenylalkyl moieties, as well as substituted phenylalkyl moieties, as in Dinsmore. Unless the Examiner is to say he interpreted the reference to “phenylalkyl” to mean *only substituted* phenylalkyl moieties, and not unsubstituted phenylalkyl moieties, there is no logical basis to conclude that the October 2, 2002 amendment raised new issues.]

In view of the foregoing, applicant requests that the reply period be re-set. Applicant submits that the February 26, 2003 action should be considered a supplementary action after a non-final rejection, giving reasons more fully. Applicant petitions that the mailing date of the February 26, 2003 Action establish a new date from which the statutory period begins to run. An amendment is

submitted herewith, which applicant believes resolves all issues raised by the May 6, 2002 action as well as the February 26, 2003 and September 6, 2002 actions. Applicant further petitions that the final rejection of May 6, 2002 be withdrawn on the ground that this was a premature, final rejection. However, in the event it is determined that prosecution is closed, applicant has submitted herewith a Request for Continued Prosecution.

II. PETITION TO REVIVE ABANDONED APPLICATION

Alternatively, in the event it is determined that the reply period may not be reset consistent with MPEP § 710.06, and/or that the final rejection of May 6, 2002 may not be withdrawn, applicant petitions to revive the instant application pursuant to 37 CFR § 1.137(a) and MPEP § 711.03(c). If the reply period is not reset, the instant application would have an abandoned status (*i.e.*, a notice of appeal or continued prosecution application was not filed by November 6, 2002, six months from the mailing of the May 6, 2002 action.)

In support of this petition, applicant relies upon the procedural history recited above. In particular, applicant notes that, following the “final rejection” of May 6, 2002, applicant timely responded with an amendment on August 6, 2002. The Advisory action of September 6, 2002 indicated that nearly all issues in the case had been resolved, with the exception of the rejection based on Dinsmore and an antecedent basis issue. With the telephonic interview of September 23, 2002, and the amendment of October 2, 2002, it appeared to applicant that all outstanding issues were resolved and that the case would proceed to issuance, as the applicant had acquiesced to each of the Examiner’s arguments. However, there was a delay in the transmittal of the October 2, 2002 response, at no fault of the applicant’s. Examiner Hong Liu confirmed during a telephonic communication on March 19, 2003, that there was a delay in the PTO’s handling of the papers. Applicant was not alerted to this delay until receipt of the February 26, 2003 Advisory action, at which point Applicant promptly filed the instant petition. (Consequently, until then, applicant had no reason to suspect the Examiner would take the position that replacing “phenyl” and “phenylalkyl” with “unsubstituted phenyl” and “unsubstituted phenylalkyl” raised new issues and required a new search).

Accordingly, applicant has promptly and diligently responded to each of the actions issued by the Examiner in this case and taken action designed to promote a speedy resolution of the case. It was unavoidable by Applicant that transmittal of the October 2, 2002 response was delayed by the USPTO.


FEES

The PTO is authorized to charge the fee for the petition to revive the instant application under 37 CFR § 1.137(a) and 1.17(l), as well as the fee for a Request for Continued Prosecution, to Deposit Account No. 18-1700.

CONCLUSION

In sum, applicant respectfully requests that the mailing date of the February 26, 2003 Action establish a new date from which the statutory period begins to run. In the event said response time is not re-set, and the application is considered abandoned, applicant petitions for revival of the instant application pursuant to 37 CFR § 1.137(a) and MPEP § 711.03(c), and submits a Request for Continued Prosecution of this application. If the PTO believes a telephone conference would expedite the prosecution of this application, it is respectfully requested that the undersigned be contacted at (650) 852-1141.

Respectfully submitted,



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